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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/784,879	02/15/2001	Ned M. Smith	42390P10821	4562

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EXAMINER

BAYAT, BRADLEY B

ART UNIT	PAPER NUMBER
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3621

DATE MAILED: 04/06/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

**Office Action Summary**

Application No.

09/784,879

Applicant(s)

SMITH ET AL.

Examiner

Bradley Bayat

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 13 January 2005.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1,2,4-10,12-17,21 and 23-25 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1,2,4-10,12-17,21 and 23-25 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_\_
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_

## **DETAILED ACTION**

### ***Continued Examination Under 37 CFR 1.114***

A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on 13 January 2005 has been entered. Examiner notes a conversation with applicant's attorney clarifying the incorrect numbering of the rejected claims in the prior action.

### ***Status of Claims***

Claims 3, 11, 18-20, and 22 were previously cancelled and claims 1, 2, 4-10, 12-17, 21, and 23-25 remain pending are again presented for examination on the merits.

### ***Response to Arguments***

Applicant's arguments with respect to the above noted claims have been considered but are moot in view of the new ground(s) of rejection.

### ***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

**Claims 1, 2, 4-10, 12-17, 21, and 23-25 are rejected under 35 U.S.C. 103(a) as being unpatentable over Dan et al. (hereinafter Dan), US Patent 6,148,290.**

1. (Previously Presented) Dan discloses a method of managing a lifecycle of an electronic contract representing a relationship between at least two parties sharing a business process comprising: exchanging public key fingerprints for each of the parties (column 8, lines 44-48); negotiating the electronic contract (column 6, lines 11-25), digitally signing and verifying the electronic contract using the key fingerprints (column 8, lines 44-66), issuing role certificates to participants of the shared business process, the role certificates defining authorization of participants to perform at least a part of the shared business process and for using the public keys (column 7, lines 17-36); registering, by the participants, to receive the electronic contract, (column 7, lines 38-47); and performing the shared business process by the participants (column 7, line 48-column 8, line 43); wherein no dominant authority and no hierarchy of parties exists between the parties, and wherein the parties enforce authorization of participants to perform elements of the shared business process without use of a trusted third party (column 6, lines 25-37). Dan does not explicitly disclose the step of distributing the electronic contract to the participants. However, this step is deemed to be inherent to the Dan system since a plurality of parties jointly negotiate a service contract having “unambiguous” rules of interaction between the parties, registering the service contract with each of the parties and generating from the service contract enforcer modules consistent with the negotiated terms and rules of the contract (column 6, lines 11-61). In other words, Dan’s contract management system provides for all permitted interactions afforded to the parties, including access and distribution of the service contract via the client or service application as described in column 6, line 63-column 7, line 16.

As per the following claims, Dan further discloses:

2. (Original) The method of claim 1, further comprising updating the shared business process by modifying the electronic contract and redistributing the electronic contract to the participants (column 8, lines 48-52).

4. (Original) The method of claim 1, wherein negotiating the electronic contract comprises determining terms and conditions of the electronic contract and defining allowable roles for participants and process elements (column 8, lines 21-43).

5. (Original) The method of claim 1, further comprising storing the electronic contract by an archive agent prior to distributing the electronic contract and wherein registering to receive the electronic contract comprises registering with a purchase/subscribe agent to receive the electronic contract by the participants (column 7, lines 24-36).

6. (Original) The method of claim 1, wherein the electronic contract is distributed to the participants according to a publish and subscribe model (column 3, line 30-column 4, line 44) .

7. (Original) The method of claim 1, further comprising terminating the electronic contract by modifying the electronic contract to halt authorization of the shared business process (column 3, lines 50-56).

8. (Original) The method of claim 1, wherein digitally signing and verifying the electronic contract comprises cross-checking each other's digital signatures on the electronic contract by the parties, without involving a trusted third party (column 8, line 44-column 9, line 8).

Claims 9-10, 12-17, 21, and 23-25 are directed to a computer storage medium/system and method as disclosed in the above method claims and are therefore rejected as above.

*Examiner has pointed out particular references contained in the prior arts of record in the body of this action for the convenience of the applicant. Although the specified citations are representative of the teachings in the art and are applied to the specific limitations within the individual claim, other passages and figures may apply as well. It is respectfully requested from the applicant, in preparing the response, to consider fully the entire references as potentially teaching all or part of the claimed invention, as well as the context of the passage as taught by the prior arts or disclosed by the examiner.*

### **Conclusion**

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure:

- US Patent 6,775,658 B1 to Zothner.
- USPAP 2002/0091579A1 to Yehia et al.

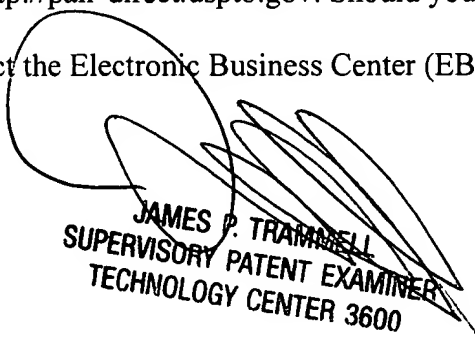
Any inquiry concerning this communication or earlier communications from the examiner should be directed to Bradley Bayat whose telephone number is 703-305-8548. The examiner can normally be reached on Tuesday-Friday during normal business hours.

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If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, James Trammell can be reached on 703-305-9768. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

bbb

  
JAMES P. TRAMMELL  
SUPERVISORY PATENT EXAMINER  
TECHNOLOGY CENTER 3600